REMARKS

Claims 1, 2, 5, 7, 8, 11, 12, 14-17, 19, 20, 22-27, 29-33 and 35-62 are pending in the present application. A Petition and Fee for a two-month Extension of Time has been simultaneously filed along with this Response. Reconsideration of the pending claims is respectfully requested for the reasons discussed below.

In the non-final rejection mailed December 13, 2004, the Examiner rejected claims 1, 24, 41, 43, 45, 46, 48, 49, 52, 54, 55, 57 and 59 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that,

> [A]pplicant amends the claim to recite the limitation "the coating is substantially clear after cooking"; this limitation is not supported by the original disclosure. This specification does not state anything about the coating being "substantially clear after cooking". In the response, applicant makes reference to the provisional applications which are incorporated by reference. The coating is an essential material in the claimed product and process. Incorporation by reference of essential material can only be made to a US patent, a US patent application publication or a pending US application. Also, the amount of rice flour of 10% and the inclusion of dextrin in the coating are not disclosed in the specification or the original claims.

Applicants have amended the specification to include portions of commonly owned copending application Nos. 60/180,666 and 60/234,153. This amendment does not present new matter because both the 60/280,666 and 60/234,153 applications were incorporated by reference in the originally filed specification. The Applicants have also forwarded the Declaration of John Stevens, one of the inventors, along with this Response and Amendment, which states that the Amendments to the specification contain the same material incorporated by reference in the originally filed application. (Stevens' Decl., ¶ 10). By this Amendment, the specification now contains an explicit written description of the limitations "the coating composition is substantially clear after cooking," the amount of rice flour of 10%, and the inclusion of dextrin in the coating. Accordingly, claims 1, 24, 41, 43, 45, 46, 48, 49, 52, 54, 55, 57 and 59 comply with 35 U.S.C. § 112, first paragraph.

The Examiner has also rejected claims 1, 24, 45, 46, 48, 54, 55 and 57 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out

and distinctly claim the subject matter which Applicants regard as the invention. In this regard, the Examiner states:

> the term 'substantially clear' is indefinite because it is not known what would be considered as substantially clear. The specification does not disclose that the coating is clear; thus, the specification does not give meaning to the term. The scope of the claim cannot be determined.

Applicants respectfully submit that the term "substantially clear" is not indefinite. The term "clear coat," which is a generic class of coatings of which Applicants' present coating is a species thereof, is a widely recognized industry term referring to coatings, which due to their makeup, result in a coating on a french fry that is substantially clear after cooking. This is in contrast to a tempura batter or spicy batter which is opaque. (Decl. of John Stevens, ¶ 9). For example, U.S. Patent No. 6,132,785 describes such a "so-called clear-coat batter." (*See* '785 patent, col. 4). Moreover, claim 15 of the '785 patent specifically uses the language: "a batter coating which is substantially clear upon finish preparation of the potato strips." Accordingly, Applicants respectfully submit the language of claims 1, 24, 45, 46, 48, 54, 55 and 57 comply with 35 U.S.C. § 112, second paragraph.

The Examiner has also rejected claims 1, 2, 5, 7, 8, 11-17, 19, 22-27, 29-31, 32-38, 39 and 40-62 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,109,024 to Cremer in view of U.S. Patent No. 5,928,693 to Friedman et al.

Initially, Applicants note that claims 13 and 34 were canceled in Applicants' Response filed November 25, 2002, and are not presently pending in the present application. Accordingly, the obviousness rejection as to claims 13 and 34 does not need to be addressed in this Response. Claims 50 and 61 have been amended to state that the coating composition comprises from 25% to 30% by weight rice flour; from 25% to 35% by weight dextrin; and from 35% to 50% by weight modified, ungelatinized potato starch.

Regarding the obviousness rejection over the '024 patent in view of the '693 patent, the Examiner admits:

> Cremer does not disclose coating the potato product with a coating comprising starch components, coating comprising 10% rice flour and dextrin, the shape having slender and elongated

> portion, a waffle and pancake shape, baking the product, adding egg, parfrying and then frozen [sic], the overall thickness of not more than about 4 cm, making a waffle shape, finish-cooking in a toaster, shape which emulates [sic] slice of a natural food, predusting with dry particulate starch and adding a stabilizer as cited in claim [sic] 50, 53.

The Examiner goes on to say that "[i]t would have been obvious to coat the Cremer potato product with the clear coat disclosed by the '693 patent for the advantage disclosed by Friedman et al."

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). In order to establish a *prima facie* case of obviousness, there must: (1) be some suggestion or motivation to modify or combine reference teachings; (2) be a reasonable expectation of success; and (3) the prior reference (or references) must teach or suggest all claim limitations. Applicants respectfully submit that the Examiner has not met her burden of establishing a *prima facie* case of obviousness with respect to the rejected claims. Consequently, the Examiner's rejection of the subject claims is inappropriate and should be withdrawn.

Applicants respectfully submit that the Examiner has made her obviousness rejection using impermissible hindsight. It is improper to base an obviousness rejection using hindsight involving knowledge that was not known at the time the claimed invention was made. *Air-Vend, Inc. v. Thorne Industries, Inc.*, 625 F. Supp 1123, 1136 (D. Minn. 1985), *judgment aff'd.*, 831 F.2d 306 (Fed. Cir. 1987).

The '024 patent involves a method of producing French fried potatoes from dehydrated granules or flakes and a water-dispersible starch derivative which has between about 10% and about 50% of an amylose starch. The amylose starch is incorporated into and not onto the dough. There is nothing in the '024 patent to suggest coating the outside of the dough. The '693 patent is generally directed to a clear coat composition for coating French fried potatoes. The '693 patent only discloses coating natural potato products. There is nothing in the '693 patent which suggests coating dough.

Applicants submit that the Examiner improperly relied on hindsight based on Applicants' disclosure to conclude that applying a clear coat to the surface of a potato product made from potato dough is obvious. The knowledge provided by Applicants' disclosure, *i.e.*, to utilize the "clear coat" coating compositions of the present invention to coat a shaped substrate made from a moldable, shape-retaining, and pliable dough, and cooking the coated dough such that the coating is substantially clear after cooking is missing from both references. Here, the cited patents are separately directed to an uncoated potato dough product and a clear coating composition applied to a natural potato product. There is nothing in the '024 patent or '693 patent, either alone or in combination, which suggests that using a coating composition for natural potatoes on a potato dough would yield a product with improved texture and eating quality. It is only Applicants' disclosure which suggests coating a pliable dough with a clear coat composition.

The present obviousness rejection is also not proper because the '024 patent to Cremer actually teaches away from applying a coating to the dough of the '024 patent. A reference is said to teach away when "a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path that was taken by the Applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). The Federal Circuit in *Gurley* went on to say that a reference which teaches away cannot be the basis of a *prima facie* obvious rejection. *Id.*

The '024 patent teaches away from applying a starch component to the outside of a potato dough. In particular, the '024 patent states:

> The formed product is placed in hot oil which is at a temperature in excess of 250° F. to make sure that the amylose component is gelatinized and preferably at a temperature in excess of 350° F. The optimum is 375° to 400° F. The temperature and time should be sufficient to cause the amylose starch component to form the "film" and prevent undue imbibition of oil. The potato product is fried until it is browned and then it is removed from the hot oil.

('024 patent, col. 5, lines 58-66). The stated purpose of incorporating the amylose starch component into the dough is to form a "film." Accordingly, for at least the above reasons, Applicants' respectively submit that because the '024 patent already teaches using an amylose

starch component to form a film, one of ordinary skill in the art would not have been motivated to coat the dough of the '024 patent with the coating of the '693 patent.

Accordingly, claims 1, 2, 5, 7, 8, 11-17, 19, 22-27, 29-31, 32-38, 39, and 40-62 would not have been obvious and unpatentable over the '024 patent in view of the '693 patent and are in condition for allowance.

The Examiner has also rejected claims 1 and 20, which is dependent under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,487,786 to Junge. In making her rejection, the Examiner asserted:

> While Junge teaches to fry the product, it would have been obvious to one skilled in the art at the time of the invention to bake the product when desiring to reduce the fat content of the product. As to the coating being substantially clear, this [sic] is not known what would be considered as substantially clear. Since the coating in Junge is made of the same material as the claimed coating, any property resulting from the coating will obviously be present in the Junge coating.

Independent claim 1 has been amended to indicate that the coating composition of the present invention is applied to a shaped substrate made from moldable, shape-retaining, and pliable dough prior to cooking and then freezing. This amendment is supported in the specification at page 5, line 6, where it states, "After being so coated, the product is parfried and frozen for storage and shipment" and at page 4, line 21 where the specification states, "These ingredients are intermixed to form a pliable or plastic dough mass having an approximate water content of 65-75% (with 70% considered optimal), which may be formed into any of the desired shapes." The characteristics of a starch slurry applied to a frozen dough which is subsequently refrozen and then fried in oil are different from a starch slurry applied to a pliable unfrozen dough which is subsequently fried in oil and then frozen. (Stevens' Decl., ¶ 14).

The '786 patent is directed toward the use of a high amylose starch enrobing slurry including a starch material of not less than 50% by weight of amylose, wheat flour and edible acid, which is used to coat an already frozen food product. The starch slurry of the '786 patent is primarily designed to provide a coating to protect a frozen product from oxidation

during storage. (Stevens' Decl., ¶ 15). The starch slurry coated frozen dough is refrozen and preferably coated with a high melting point lipid. The '786 patent does not disclose application of a slurry to a pliable dough. (Stevens' Decl., ¶ 17). The frozen dough of the '786 patent would not be pliable, but rather solid and rigid, at the temperatures described in the '786 patent. (Stevens' Decl., ¶ 16). The starch slurry coated frozen dough is refrozen and preferably coated with a high melting point lipid. The '786 patent does not disclose application of a slurry to a pliable dough. (Stevens' Decl., ¶ 17).

If the coating composition of the '786 patent was applied to a pliable dough that was not subsequently fried in oil before freezing, the coating would not set and therefore would run off the substrate whenever the product rises above freezing temperature resulting in some, if not large, portions of the product clumping together. (Stevens' Decl., ¶ 18). In fact, unless subsequently coated with a high melting point lipid, "an unprotected starch coating [of the '786 patent] would melt in a manner similar to ice cream," if exposed to temperatures above freezing (col. 4, lines 45-47). Accordingly, Applicants respectfully submit that independent claim 1 as amended would not have been obvious over the '786 patent. Claim 20 depends from independent claim 1. Accordingly, Applicants submit that claims 1 and 20 are in condition for allowance.

The Applicants have made an effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there is any remaining formalities or other issues needing Applicants' assistance, Applicants request the Examiner to call the undersigned attorney.

Respectfully submitted,

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